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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/595,095

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Kishore Udipi

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MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

EXAMINER

GULLEDGE, BRIAN M

ART UNIT

PAPER NUMBER

1612

NOTIFICATION DATE

DELIVERY MODE

12/30/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.vasciplegal@medtronic.com

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/595,095 | Applicant(s) UDIPI ET AL. | |
| | Examiner Brian Gullledge | Art Unit 1612 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Previous Rejections

Applicants' arguments, filed 8 November 2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The Examiner notes that the 103(c) statement that was previously made with regards to the Lyu et al. reference (US Patent Application Publication 2004/0047911) has been withdrawn, with the Applicant noting that it is not entirely clear that the statement was valid in view of the current facts. This previously presented statement was the reason the rejections under 35 USC 103 of the first non-final rejection (mailed 19 November 2009) were withdrawn. In view of the withdrawal of the 103(c) statement, the Lyu et al. reference is now considered to be prior art, and rejections based on this reference are considered proper. However, in the interest of compact prosecution, rejections over Lyu et al. are not being presented, as this would require a new ground of rejection (the claims being amended when the now withdrawn 103(c) statement was originally presented), and thus this action would necessarily be non-final. In order to expedite and close prosecution, the rejections made in the last action are maintained, and no new rejections over Lyu et al. are being presented.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13 and 15-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benz et al. (US Patent Application Publication 2003/0162905) in view of Shalaby et al. (US Patent Application Publication 2003/0199964) and Van Krevelen (“Properties of Polymers,” 1990, Elsevier, 3rd Edition, Chapter 7, pages 189-225). The Applicant argues that the rejection is not proper. The Applicant states that the Examiner made merely conclusionary statements without providing a rationale, and that the combination is based on the mere fact that each reference teaches some element of the invention. The Applicant also states that the claims recite a limitation to the relative solubility parameters, and there is no teaching or suggestion of this element.

The Examiner acknowledges the presented arguments, but does not consider them persuasive. The rejection did not merely present the elements as taught and conclude the invention was obvious without providing a rationale. A reason was provided for using the vinyl acetate block, namely that Benz taught that this block would allow for adhesion of a polymeric coating to the stent, and Shalaby et al. teaches that it is desirable for the coating to adhere to the stent. And the reason to combine the polymeric materials was based on case law and as discussed in MPEP 2144.06), which was also cited to support the reasoning for the modification.

As for the solubility parameters, initially, the Examiner notes that the polymeric materials disclosed by Benz and Shalaby et al. inherently possess solubility parameter values, and thus inherently meet the claimed limitation. There is no requirement that inherent features be

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recognized by the references for a rejection to be proper. See MPEP 2112(II). Additionally, the rejection was based in part on the Van Krevelen reference, which taught the desirability of keeping the solubility parameters of polymeric materials similar in order to prepare a miscible blend.

Claims 14 and 22-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benz et al. (US Patent Application Publication 2003/0162905), Shalaby et al. (US Patent Application Publication 2003/0199964), and Van Krevelen ("Properties of Polymers," 1990, Elsevier, 3rd Edition, Chapter 7, pages 189-225), as applied to claim 13 above, and further in view of Sirhan et al. (US Patent Application Publication 2002/0082677). The Applicant presented no arguments specifically directed to this rejection, and for the reasons discussed above, the arguments against the rejection of claim 13 are not considered persuasive.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gulledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gollamudi S Kishore/
Primary Examiner, Art Unit 1612

BMG